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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|---|-------------|----------------------|---------------------------|------------------------|
| 10/700,802  | 11/03/2003  | Thomas Postlinski    | 81099/7114                | 6271                   |
| 37123 7590 05/16/2007<br>FITCH EVEN TABIN & FLANNERY<br>120 SOUTH LASALLE SUITE 1600<br>CHICAGO, IL 60603 |             |                      | EXAMINER<br>SHIBRU, HELEN |                        |
|   |             |                      | ART UNIT<br>2621          | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>05/16/2007   | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/700,802

Applicant(s)

POSLINSKI ET AL.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/22/05&amp;06/20/05</u> . | 6) <input type="checkbox"/> Other: _____  |

*Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 recites the limitation "the delete flag" in line 4 of page 13. There is insufficient antecedent basis for this limitation in the claim. The Examiner read the limitation as "ending flag."

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada (US Pat. No. 2004/0264947A1).

Claims 8-16 will be discussed first.

Regarding claim 8, Okada discloses a method of increasing the available storage space on a personal video recorder comprising the steps of: storing a media file on a memory of the personal video recorder (see paragraphs 0222, 0378, 0379 and fig. 16); receiving a signal for marking a starting flag for the media file (see paragraphs 0367 and 0373); receiving a signal for marking an ending flag for the media file (see paragraph 0367); and freeing the memory of the

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personal video recorder that contains a portion of the media file between the starting flag and the ending flag (see paragraphs 0222, 0713, and figs. 6A-B).

Regarding claim 9, Okada discloses the freeing of the memory of the personal video recorder comprises deleting the portion of the media file between the starting flag and the ending flag (see paragraphs 0367, 0373 and 0708).

Regarding claim 10, Okada discloses the freeing of the memory of the personal video recorder comprises deallocating the memory of the personal video recorder containing the portion of the media file between the starting flag and the ending flag (see paragraph 0366 and 0372).

Regarding claim 11, Okada discloses the marking of the start flag comprises marking a first presentation time stamp and wherein the marking of the end flag comprises marking a second presentation time stamp (see paragraph 0368).

Regarding claim 12, Okada discloses a first full frame image with the first presentation time stamp (see figs 7A-D and paragraphs 0238 and 0246); associating a second full frame image with the second presentation time stamp (see paragraphs 0238 and 0246).

Regarding claim 13, Okada discloses a method of increasing the available storage space on a personal video recorder comprising the steps of: searching for a start program time stamp marking a video file (see paragraphs 0030 and 0878); searching for a first full image frame related to the start program time stamp (see paragraphs 0030 and 0879); searching for an end program time stamp marking the video file (see paragraphs 0030 and 0880); searching for a second full image frame related to the end program time stamp (see paragraphs 0880, 0882 and

figs 47A-B); and deleting a portion of the video file between the first full image frame and the second full image frame (see paragraphs 0881 and figs. 71-73).

Regarding claim 14, Okada discloses the step of deleting a portion of the video file creates a plurality of video segments (see fig. 74).

Regarding claim 15, Okada discloses combining the plurality of video segments into a second video file (see paragraphs 0882-0886).

Regarding claim 16, Okada discloses the deleting comprises removing at least a portion of a commercial within the video file (see paragraph 0222).

Regarding claim 1, Okada discloses a method of increasing the available storage space on an electronic storage medium comprising the steps of: providing a free memory list for the electronic storage medium (see paragraphs 0367 and 0373 where portion selected to be deleted); selecting a portion of a file stored on the electronic storage medium (see paragraphs 0373 and 0308, portion of the file deleted); and adding the selected portion of the file to the free memory list (see paragraphs 0223 space is freed after deletion).

Regarding claims 2 and 5, Okada discloses the file is an audio file or a video file (see fig. 74).

Regarding claim 3, Okada discloses the selecting the portion of the file stored on the electronic storage medium creates a plurality of file segments (see figs 7A-D, 15A-C, and 74).

Regarding claim 4, Okada discloses the step of linking the plurality of file segments together (see paragraphs 0853-0863).

Regarding claims 6 and 7, Okada discloses the electronic storage medium is a memory of a personal video recorder (see fig. 16 and paragraph 0222).

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakanishi et al. US PG PUB 2004/0027890 A1.

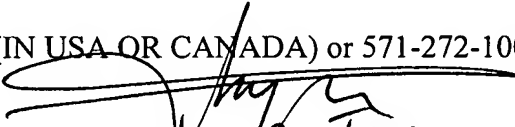
Weber et al. US PG PUB 2003/0115274 A1.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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